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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Harry D. Lewis

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EXAMINER

LUX, MICHAEL P

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,241	LEWIS, HARRY D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael P. Lux	4127	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION.**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yin (2002/0091539) in view of 65 Fed. Reg. 82796 (Dec. 28, 2000).**

As per claim 1, Yin teaches the method for creating and managing multilateral contractual relationships among contracting parties under a privacy standard, said contracting parties comprising (1) "covered entities" receiving data of customers and creating, recording, using, and disclosing private data of such customers in the ordinary course of business and (2) "business associates" requiring the use of said private data, said method comprising the steps of:

- (a) assigning digital identities to the contracting parties (via ¶'s 126-127);
- (b) providing a multilateral Master Business Associate Contract (MBAC) template (via the contract template based on XML, ¶ 136 lines 3-4);
- (c) providing an electronic interface accessible to said digital identities to facilitate negotiating and entering binding multilateral contractual agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said MBAC template (the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. The process repeats until the two parties agree on the terms, ¶ 143 lines 407); and

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(d) storing said multilateral contractual agreements in an MBAC database. (the final signed document will be saved, ¶ 143 line 8)

However, Yin fails to explicitly disclose that the template has non-negotiable terms requiring observation of said privacy standard with respect to said private data of customer.

The Federal Registrar teaches that Federal rules require non-negotiable terms that require observation of privacy standards with respect to customer data. For example, Section 164.530 requires an entity to maintain specific policies and procedures in written or electronic form to protect health information.

It would have been obvious to one skilled in the art of contractual agreements to modify the method for creating contracts of Yin with the non-negotiable terms as taught by the Federal Registrar in order to protect the privacy of the medical data of customers. Motivation is evident based on the fact that these agreements are common and any automation would save a great deal of time.

**As per claim 3**, Yin teaches the method wherein said electronic interface includes interactive means for negotiating additional terms with respect to the use or disclosure of said private data (the action of save a contract triggers the negotiation process sending the contract to the addressed party, ¶143 lines 1-3)

**3. Claims 2, 4, 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yin (2002/0091539) and 65 Fed. Reg. 82796 (Dec. 28, 2000), as applied to claim 1 above, and further in view of Smithies (5,818,955).**

**As per claim 2**, the Yin and Fed. Reg. combination fails to teach the additional step of providing self-certification provisions in said MBAC for contracting parties to certify adherence

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to said privacy standard as self certified covered entities or as self-certified business associates. However, Smithies provides a document and signature verification system including a sample self-certification form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification form can be modified to adhere to any contractual agreement. It would have been obvious to one skilled in the art of electronic contractual agreements to modify the self-certification form and use within the Yin and Fed. Reg. system.

Motivation to combine the Smithies self-certification form with the Yin and Fed. Reg. combination is the fact that the self-certification allows agreements that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

**As per claim 4**, Yin teaches the method for creating and managing multilateral contractual relationships among contracting parties under a privacy standard, said contracting parties comprising (1) “covered entities” receiving data of customers and creating, recording, using, and disclosing private data of such customers in the ordinary course of business, and (2) “business associates” requiring use of said private data, said method comprising the steps of:

- (a) assigning digital identities to the contracting parties (via ¶’s 126-127);
- (b) providing a multilateral Master Business Associate Contract (MBAC) template (via the contract template based on XML, ¶ 136 lines 3-4);
- (d) providing an electronic interface accessible to said digital identities to facilitate negotiating and entering binding multilateral contractual agreements among a least one of said self certified covered entities and a plurality of said self- certified business associates pursuant to the terms of said MBAC template (the addressed party adds or modifies clauses to the document

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and save[s] it. The saving process presents the document to the originating party highlighting the changes. The process repeats until the two parties agree on the terms, ¶ 143 lines 407); and

(e) storing said multilateral contractual agreements in an MBAC database. (the final signed document will be saved, ¶ 143 line 8)

However, Yin fails to explicitly disclose that the template has non-negotiable terms requiring observation of said privacy standard with respect to said private data of customer.

The Federal Registrar teaches that Federal rules require non-negotiable terms that require observation of privacy standards with respect to customer data. For example, Section 164.530 requires an entity to maintain specific policies and procedures in written or electronic form to protect health information.

It would have been obvious to one skilled in the art of contractual agreements to modify the method for creating contracts of Yin with the non-negotiable terms as taught by the Federal Registrar in order to protect the privacy of the medical data of customers. Motivation is evident based on the fact that these agreements are common and any automation would save a great deal of time. Yin further fails to disclose (c) providing self-certification procedures for contracting parties to certify adherence to said privacy standard as self-certified covered entities or as self-certified business associates.

Smithies provides a document and signature verification system including a sample self-certification form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification form can be modified to adhere to any contractual agreement. It would have been obvious to one skilled in the art of electronic

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contractual agreements to modify the self-certification form and use within the Yin and Fed. Reg. system.

Motivation to combine the Smithies self-certification form with the Yin and Fed. Reg. combination is the fact that the self-certification allows agreements that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

**As per claim 7**, Yin teaches the method wherein said electronic interface includes interactive means for negotiating said additional terms with respect to use or disclosure of said private data. (In the simplest scenario the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. This process repeats until the two parties agree on the terms. ¶ 143, lines 3-7)

**As per claim 8**, Yin teaches the method wherein said interactive means includes means for a covered entity to offer and for a business associate to accept said non-negotiable terms in the MBAC. (In the simplest scenario the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. This process repeats until the two parties agree on the terms. ¶ 143, lines 3-7)

**As per claim 9**, Yin teaches the method including the additional step of accessing a selected multilateral contractual agreement in said MBAC database for permission to disclose selected private data to a selected self-certified business associate. (via a rules analyzer engine that “retrieves from the data store information in the database”. These rules then “help guide the business between the partnering providers”. ¶ 108, lines 4-10)

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**As per claim 10**, Yin teaches the method wherein said electronic interface comprises the internet. (Paragraph 144 discloses an example of a user utilizing web pages and HTML, lines 6-7)

**4. Claims 5, 6, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yin (2002/0091539), 65 Fed. Reg. 82796 (Dec. 28, 2000), and Smithies (5,818,955) as applied to claim 4 above, and further in view of Examiner's Official Notice.**

**As per claim 6**, Examiner takes Official Notice that warranty clauses are extremely old and well known in the art of contract negotiations. It would have been extremely obvious to one skilled in the art of contract negotiations to have a warranty clause in the MBAC. Motivation is evident as the creation of a warranty clause allows for more complete negotiation and prevents future litigation.

**As per claim 5**, Yin fails to teach the method wherein said self-certification procedures comprise the additional steps of:

providing a self-certification standard affidavit template for self-certification by electronic signature; and

storing affidavits corresponding to said template in a separate self-certification database.

However, Smithies teaches a self-certified affidavit template, such as the one shown in Figure 3A, for self-certification by electronic signature and storing of these affidavits in a database. Examiner takes Official Notice that it is old and well known in the art of database management to use multiple files or databases for storing information.

It would have been obvious to modify the method of Yin and Smithies, as modified above, to store contract data and save data in more than one database as taught by Examiner's

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Official Notice in order to keep more sensitive signature data apart from the contract information.

**As per claim 11**, Yin teaches the method for creating and managing multilateral contractual relationships among contracting parties under a privacy standard applicable to protected health information (PHI), said contracting parties comprising (1) “covered entities” receiving data of customers and creating, recording, using, and disclosing PHI data of such customers in the ordinary course of business, and (2) “business associates” requiring the use of said PHI data, said method comprising the steps of:

- (a) assigning digital identities to the contracting parties (via ¶’s 126-127);
- (b) providing a multilateral Master Business Associate Contract (MBAC) template (via the contract template based on XML, ¶ 136 lines 3-4);
- (e) providing an electronic interface accessible to said digital identities, said electronic interface being selectively connectable to the self-certification database to facilitate negotiating and entering binding multilateral contractual agreements among at least one of said self-certified covered entities and a plurality of said self-certified business associates pursuant to the terms of said affidavits and said MBAC template (the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. The process repeats until the two parties agree on the terms, ¶ 143 lines 407); and
- (f) storing said multilateral contractual agreements in an MBAC database. (the final signed document will be saved, ¶ 143 line 8)

However, Yin fails to explicitly disclose that the template has non-negotiable terms requiring observation of said privacy standard with respect to said PHI data of customer.

The Federal Registrar teaches that Federal rules require non-negotiable terms that require observation of privacy standards with respect to customer data. For example, Section 164.530 requires an entity to maintain specific policies and procedures in written or electronic form to protect health information.

It would have been obvious to one skilled in the art of contractual agreements to modify the method for creating contracts of Yin with the non-negotiable terms as taught by the Federal Registrar in order to protect the privacy of the medical data of customers. Motivation is evident based on the fact that these agreements are common and any automation would save a great deal of time.

Yin further fails to disclose (c) providing a self certification standard affidavit template for contracting parties to certify adherence to said privacy standard as self-certified covered entities or as self-certified business associates by electronic signature so as to achieve self-certification; and (d) storing affidavits corresponding to said template in a separate self-certification database.

However, Smithies teaches a self-certified affidavit template, such as the one shown in Figure 3A, for self-certification by electronic signature and storing of these affidavits in a database. While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification form can be modified to adhere to any contractual agreement. It would have been obvious to one skilled in the art of electronic contractual agreements to modify the self-certification form and use within the Yin and Fed. Reg. system. Examiner takes Official

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Notice that it is old and well known in the art of database management to use multiple files or databases for storing information.

It would have been obvious to modify the method of Yin and Smithies, as modified above, to store contract data and save data in more than one database as taught by Examiner's Official Notice in order to keep more sensitive signature data apart from the contract information.

**As per claim 12**, Yin teaches the method wherein said electronic interface includes interactive means for negotiating said additional terms with respect to use or disclosure of said PHI data. (In the simplest scenario the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. This process repeats until the two parties agree on the terms. ¶ 143, lines 3-7)

**As per claim 13**, Yin teaches the method wherein said interactive means includes means for a covered entity to offer and for a business associate to accept said non-negotiable terms in the MBAC. (In the simplest scenario the addressed party adds or modifies clauses to the document and save[s] it. The saving process presents the document to the originating party highlighting the changes. This process repeats until the two parties agree on the terms. ¶ 143, lines 3-7)

**As per claim 14**, Yin teaches the method including the additional step of accessing a selected multilateral contractual agreement in said MBAC database for permission to disclose selected PHI data to a selected self-certified business associate. (via a rules analyzer engine that "retrieves from the data store information in the database". These rules then "help guide the business between the partnering providers". ¶ 108, lines 4-10)

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**As per claim 15**, Yin teaches the method wherein said electronic interface comprises the internet. (Paragraph 144 discloses an example of a user utilizing web pages and HTML, lines 6-7)

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wheeler (2003/0177361) teaches a method and system for using electronic communication for a contract. Donahue (7,146,343) teaches a method and apparatus for negotiating a contract over a computer network. Lastly, Dray (2002/184485) teaches a method for self-verification of electronic documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Lux whose telephone number is 571-270-5104. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elaine Gort

Primary Examiner

mpl